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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/531,120 03/17/00 PREUSS

D ARCD: P-01912

EXAMINER

HM12/0815

FULBRIGHT & JAWORSKI LLP
600 CONGRESS AVENUE
SUITE 2400
AUSTIN TX 78701

EINGSMANN, J

ART UNIT

PAPER NUMBER

1655

14

DATE MAILED:

08/15/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/531,120

Applicant(s)

PREUSS ET AL.

Examiner

Juliet C. Einsmann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-230 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-230 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: _____

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-43 and 92-127, drawn to recombinant constructs containing an *A. thaliana* chromosome 1 centromere and host cells, classified in class 536, subclass 23.1.
 - II. Claims 1-40, 44-63, and 92-127, drawn to recombinant constructs containing an *A. thaliana* chromosome 2 centromere and host cells, classified in class 536, subclass 23.1.
 - III. Claims 1-40, 64-66, and 92-127, drawn to recombinant constructs containing an *A. thaliana* chromosome 3 centromere and host cells, classified in class 536, subclass 23.1.
 - IV. Claims 1-40, 67-88, and 92-127, drawn to recombinant constructs containing an *A. thaliana* chromosome 4 centromere and host cells, classified in class 536, subclass 23.1.
 - V. Claims 1-40, 89-91, and 92-127, drawn to recombinant constructs containing an *A. thaliana* chromosome 5 centromere and host cells, classified in class 536, subclass 23.1.
 - VI. Claims 128-133, drawn to transgenic plants and methods for making transgenic plants, classified in class 800, subclass 295.
 - VII. Claims 147-163, drawn to methods for producing mini-chromosome vectors, classified in class 435, subclass 91.1.

- VIII. Claims 164-170, drawn to methods of screening a candidate centromere for plant activity, classified in class 435, subclass 468.
- IX. Claims 171-185, drawn to an *Aribodipsis* polyubiquitin 11 promoter, classified in class 536, subclass 24.1.
- X. Claims 186-200, drawn to an *Arabidopsis* 40S ribosomal protein S16 promoter, classified in class 536, subclass 24.1.
- XI. Claims 201-215, drawn to an *Arabidopsis* polyubiquitin 11 3' regulatory sequence, classified in class 536, subclass 24.1.
- XII. Claims 216-230, drawn to an *Arabidopsis* 40S ribosomal protien S16 3' regulatory sequence, classified in class 536, subclass 24.1.

Further Election Required of Groups which Recite SEQ ID numbers

Claims 102, 108, 141, and 231 each contain listings of multiple SEQ ID numbers.

Applicant is required to elect a single sequence for examination. Each of these sequences represent distinct nucleic acid molecules which differ in chemical structure and function. Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

It is noted that groups I-V each contain claims generic claims 1-40 and 103-108.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed invention for prosecution on

the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the invention that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional inventions which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected invention.

Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

The inventions are distinct, each from the other because of the following reasons:

2. The centromeres of groups I-V are different from one another because they comprise different molecules, as is evidenced by the fact that they have distinct nucleic acid sequences and thus different structural properties. These molecules represent separate and distinct inventions.
3. The centromeres of groups I-V are distinct products from the plants of group VI. The plants of group VI are complex biological systems, while the centromeres of groups I-V are

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comprised primarily of nucleic acids. Insofar as the centromeres of groups I-V are related to the methods contained in group VI as a product and process of using, the products of groups I-V can be used in other methods, such as for the transformation of individual cells for the expression of heterologous proteins.

4. Inventions I-V and invention VII are related as process of making and product made.

The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the products of inventions I-V could be made by other method such as via chemical synthesis.

5. Inventions I-V and invention VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the products of inventions I-V are useful in other methods such as to transform cells.

6. Inventions I-V and inventions IX-XII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions these inventions are all distinct chemical molecules with different structures (i.e. nucleic acid sequences) and functions.

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7. The remaining inventions are unrelated to one another. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions these inventions are all distinct chemical molecules with different structures (i.e. nucleic acid sequences) and functions. The methods all represent distinct methods with different goals and process steps, and requiring different reagents. Products of inventions IX-XII are not disclosed as being used in the methods of inventions VI-VIII.

8. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as demonstrated by their different classification and recognized divergent subject matter and because inventions I-XII require different searches that are not coextensive, examination of these claims would pose a serious burden on the examiner and therefore restriction for examination purposes as indicated is proper.

9. A telephone call was made to Robert Hanson on 8/14/01 to discuss the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the


application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Juliet C. Einsmann whose telephone number is (703) 306-5824. The examiner can normally be reached on Monday through Thursday, 7:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones can be reached on (703) 308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 and (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.


JEFFREY FREDMAN
PRIMARY EXAMINER


Juliet C. Einsmann
Examiner
Art Unit 1655

August 14, 2001